

REMARKS/ARGUMENTS

Upon entry of the Amendment, which amends Claims 9 and 13, and adds new Claims 14-20, Claims 1 and 3-20 remain pending in the present application.

In the November 23, 2004 Office Action, Claims 1, 6, 9 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,576,692 to Tompkins et al. (hereinafter referred to as “Tompkins et al.”) in view of U.S. Patent No. 5,684,859 to Chanroo et al. (hereinafter referred to as “Chanroo et al.”), and further in view of U.S. Patent No. 6,342,836 to Zimmerman (hereinafter referred to as “Zimmerman”). Claims 4, 5, 11 and 12 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tompkins et al., in view of Chanroo et al., in view of Zimmerman, and further in view of U.S. Patent No. 6,236,836 to Westman et al. (hereinafter referred to as “Westman et al.”). Claim 3 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tompkins et al., in view of Chanroo et al., in view of Zimmerman, and further in view of U.S. Patent No. 6,412,086 to Friedman et al. (hereinafter referred to as “Friedman et al.”). Finally, Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tompkins et al., in view of Chanroo et al., in view of Zimmerman, and further in view of U.S. Patent No. 6,424,928 to Elliott et al. (hereinafter referred to as “Elliott et al.”). Applicant respectfully requests reconsideration of the claims in view of the above amendments and the comments below.

35 U.S.C. § 103(a) Claim Rejections – Claims 1, 6, 9 and 13

In the November 23, 2004 Office Action, Claims 1, 6, 9 and 13 were rejected for allegedly being obvious over Tompkins et al. in view of Chanroo et al, and further in view of Zimmerman. For the following reasons, Applicant respectfully disagrees.

Tompkins et al. discloses a system for tracking luggage in airports dispersed over a wide geographic area. The system utilizes a paging system and beeper paging units attached to each piece of luggage to be tracked or located. Each beeper paging units is assigned a unique code, so that luggage pieces can be distinguished from one another.

Chanroo et al. discloses a “selective call system” comprising a paging controller 104 coupled to a telephone network 102, a plurality of base sites 120-124, a subscriber database 130 containing location identifiers 132. A subscriber uses a selective call receiver 108, which receives call signals from the paging controller 104. A decoder/controller 306 of a selective call receiver 108 assigned to a particular subscriber compares a location identifier 132 sent from a base site of a given service area to the subscriber’s home location identifier to determine whether the subscriber has roamed to a new service area. If it is determined that the subscriber has roamed to a new service area, the selective call receiver 108 transmits an acknowledgment-back signal to the base sites of the new service area. The selective call receiver 108 also sends the new location identifier to the subscriber’s home service area so that all paging information can be routed to the new service area indicated by the new location identifier.

Zimmerman discloses a proximity and sensing system for luggage that employs a location unit 41 (Figure 6) and an indicator unit 81 (Figure 7) that communicates directly with the location unit 41 when the two units are within communications range of one

another. The location unit 41 is carried within luggage 37, while the indicator unit 81 is carried by a user (e.g. an aircraft passenger 27). Figure 6 and column 10, line 62 through column 11, line 48 illustrate and describe how the location unit 41 may be a pager receiver, or a receiver for receiving signals on several frequencies from the indicator unit 81. Column 5, lines 30-33 describe how the location unit 41 may also include a transponder, thereby making the location unit a transceiver. Figure 6 and column, 11, line 49 through col. 14, line 55 illustrate and describe the indicator unit 81.

Claim 1 of the present invention, by contrast, claims an apparatus for determining the location of an item that includes a “paging device” and a “transponder tag...co-located on or near said item”. Tompkins et al., Chanroo et al. and Zimmerman, whether considered alone, in combination, or whether modified by one another, do not teach or suggest a system for locating an item having a paging device co-located with a transponder tag. In fact, none of the references teach or suggest use of a “transponder tag”, let alone a transponder tag co-located with a paging device. This distinction was pointed out in previous communications. For at least this first reason, therefore, the § 103(a) rejection of independent Claim 1, as allegedly being obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman, cannot be properly maintained.

Not only is there is there no teaching of a transponder tag in any of the cited references, there is also no suggestion or motivation expressed in the cited references that the references could be modified to use a transponder tag. Applicant also respectfully believes that at the time of Applicant’s invention, there was no knowledge generally available to one of ordinary skill in the art that would suggest or motivate a modification

of the references to include a transponder tag co-located with a pager. Such a suggestion or motivation could only possibly be found by reliance on Applicant's disclosure.

However, reliance on Applicant's disclosure is impermissible. See M.P.E.P. § 2143, which directs that: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). (emphasis supplied). For at least this second reason, therefore, the § 103(a) rejection of independent Claim 9, as allegedly being obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman, cannot be properly maintained.

Independent Claim 1 also includes a "locator transmitter, adapted to be co-located with said item and said paging device,...producing a locator signal...." and a "locator device, within range to receive said locator signal, for determining the location of said locator transmitter." In the Office Action, it is acknowledged that neither Tompkins et al. nor Chanroo et al. teach or suggest this characteristic, but asserts that Zimmerman does. Applicant respectfully disagrees. Zimmerman does not teach or suggest a "locator transmitter" that produces a "locator signal", and does not include a "locator device" that determines the "location" of the baggage. The indicator unit 81 in Zimmerman system is only capable of determining whether a baggage unit containing the location unit 41 is in receiving range of the indicator unit 81. In other words, it can only determine proximity, not location. Further, when the location unit 41 is beyond the reception capability of the indicator unit 81, not even the presence of the baggage and baggage unit can be ascertained. By contrast, the "locator device" element of Claim 1 recites that the "locator device" is "within range to receive said locator signal." Hence, unlike Zimmerman, the

presence and location of an item is always determinable. Accordingly, for at least this third reason, the § 103(a) rejection of independent Claim 1, as allegedly being obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman, cannot be properly maintained.

Fourth, none of the cited references, whether considered alone, in combination, or modified by one another teach or suggest a system having a “computer” coupled to a “transponder reader” and having stored therein, in association with each other, “both” a “paging device identification code” and a “tag identification code.” Indeed, there is no teaching or suggestion whatsoever in the references of a system having a computer that stores both a paging device identification code and a tag identification code. While this lack of teaching or suggestion in the cited references is acknowledged in the Office Action, it is nevertheless asserted that “[o]ne skilled in the art recognizes that the tag and the paging device are associated with the same item (baggage) so their identification numbers are associated.” Applicant respectfully disagrees with this reasoning since it relies on Applicant’s disclosure and impermissible hindsight to support the rejection.

As discussed above, M.P.E.P. § 2143 directs that: “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.” (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). (emphasis supplied). Neither the cited prior art nor the knowledge generally available to one of ordinary skill in the art provide any suggestion or motivation to configure a computer to store associated tag and paging device identification codes. The only way that one skilled in the art would understand that a computer would be configured in this manner is by reference to Applicant’s

disclosure. Accordingly, for at least this fourth reason, the § 103(a) rejection of independent Claim 1, as allegedly being obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman, cannot be properly maintained.

Claim 6 was also rejected for allegedly being obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman. Claim 6 depends from independent Claim 1. Consequently, it derives patentability for depending from what appears to be an allowable base claim.

Independent Claim 9 was also rejected for allegedly being obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman. For the following reasons, Applicant respectfully disagrees.

First, as explained above (as well as in previous responses), neither Tompkins et al. nor Chanroo et al. disclose a system or apparatus in which an item to be located includes (either attached or in close proximity) both a paging device and a “transponder tag”. Indeed, there is absolutely no teaching or suggestion of a “transponder tag” in any of the cited references. Further, there is no suggestion or motivation expressed in the cited references that the references could be modified to use a transponder tag. Additionally, Applicant respectfully believes that at the time of Applicant’s invention there was no knowledge generally available to one of ordinary skill in the art that would suggest or motivate a modification of the references to include a transponder tag co-located with a pager. Such a suggestion or motivation could only possibly be found by impermissible reliance on Applicant’s disclosure. (*See* M.P.E.P. § 2143.) For at least this first reason, therefore, the § 103(a) rejection of independent Claim 9, as allegedly being

obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman, cannot be properly maintained.

Second, Claim 9 includes “a computer configured to store said paging device address and said tag identification code.” In the Office Action, it is acknowledged that none of the cited references teach or suggest this aspect of Claim 9. Despite this fact, it is asserted, nevertheless, that “[o]ne skilled in the art recognizes that the tag and paging device are associated with the same item (baggage) so their identification numbers are associated.” Applicant respectfully disagrees. As explained above in response to the rejection of Claim 1, the proposed suggestion or motivation to combine impermissibly relies on hindsight and the benefit of Applicant’s disclosure. The proposed suggestion or motivation is also faulty in that it presupposes that the cited references disclose a “transponder *tag*” co-located with a paging device. As explained above, there is absolutely no teaching or suggestion of such a combination in the cited references.

For at least the foregoing reasons, the § 103(a) rejection of independent Claim 9, as allegedly being obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman, cannot be properly maintained.

Claim 13 was also rejected for allegedly being obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman. For the following reasons, Applicant respectfully disagrees.

First, Claim 13 depends from independent Claim 9. Accordingly, it derives patentability for depending from what appears to be an allowable base claim. Second, despite what is asserted in the Office Action, Tompkins et al. does not teach or suggest a paging device that “includes a short-range transmit module”, or a short-range transmit

module “configured to transmit a short-range location signal to a location receiver module having one or more receivers operable to determine the location of said paging device.” For at least these reasons, the § 103(a) rejection of dependent Claim 13, as allegedly being obvious over Tompkins et al. in view of Chanroo et al., and further in view of Zimmerman, cannot be properly maintained.

Remaining Dependent Claims

In the Office Action, dependent Claim 3 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tompkins et al., in view of Chanroo et al., in view of Zimmerman, and further in view of Friedman et al. Claim 3 depends from independent Claim 1, which as described above is believed to be allowable over the cited prior art. Accordingly, Claim 3 derives patentability for depending from an allowable base claim. The addition of Friedman et al. does nothing to alter this result.

Claims 4, 5, 11 and 12 were also rejected for allegedly being obvious over Tompkins et al. in view of Chanroo et al., in view of Zimmerman, and further in view of Westman et al. Claims 4 and 5 depend from independent Claim 1, and Claims 11 and 12 depend from independent Claim 9. Accordingly, Claims 4, 5, 11 and 12 derive patentability for depending from allowable base claims. The addition of Westman et al. does nothing to alter these results.

Finally, Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tompkins et al., in view of Chanroo et al., in view of Zimmerman, and further in view of Elliott et al. Claims 7 and 8 depend from independent Claim 1.

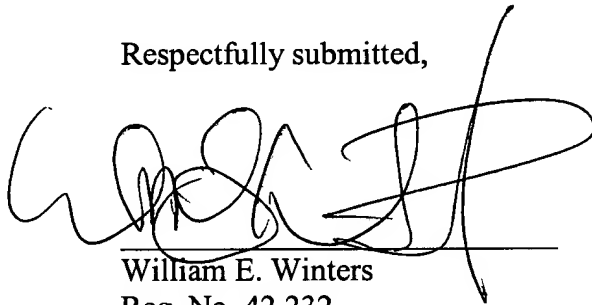
Accordingly, Claims 7 and 8 derive patentability for depending from an allowable base claim. The addition of Elliott et al. does nothing to alter this result.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-282-1857.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. E. Winters', is written over a horizontal line. The signature is stylized with loops and a long horizontal stroke extending to the right.

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Dated: MARCH 23, 2005

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